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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/431,833

Filing Date: November 02, 1999
Appellant(s): BIGUS ET AL.

Scott Stinebruner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/13/2007 appealing from the Office action mailed 06/22/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is not correct. This Examiner's Answer contains a new grounds of rejection.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,613,012	Hoffman et al	3/1997
5,983,200	Slotznick	11/1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 54-63 and 104-112 are rejected under 35 U.S.C 103 (a) as being unpatentable over Hoffman et al (U.S. Patent No. 5,613,012) in view of Slotznick (U.S. pat. No. 5,983,200).

As per claims 54, 60, 61, 113 and 114 Hoffman substantially a method comprising determining at least one attribute related to the unknown party, wherein the unknown party is a party other than a client that has a delegated at least on task to the intelligent agent (intelligent agent or tokenless identification), comparing (comparing or examining, see., Hoffaman, col 7, lines 13-35) the attribute for the unknown party with attributes related to a plurality of known parties, and identifying the unknown party as the known party having the attribute which most closely matches that of the unknown party and a signal bearing media bearing the program (see., abstract, col 2, lines 58-col 3, line 15, col 4, lines 38-62, col 7, lines 19-55, col 8, lines 11-63, col 18, line 9- col 20, line 64). Hoffman discloses an inventive concept of identifying an unknown party interacting with

an intelligent agent. However, Slotznick discloses an inventive concept of identifying an unknown party interacting with an intelligent agent (see., abstract, col 13, line 14-36, line 13, col 17, lines 35-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hoffman's invention concept to include Slotznick invention concept of identifying an unknown party interacting with an intelligent agent because this would have assisted the human being in applying the functional capabilities of computer systems in order to reducing the amount of interaction between human and system, freeing a human for order concerns and activities that humans are uniquely good at, including decision-making situation assessment, goal-setting, etc; and reducing a user's requirements for training and knowledge, allowing the human operator to devote more training on domain knowledge and skills and less on computer-system knowledge and skills.

As per claims 55 and 108 Hoffman discloses a method of comparing the plurality of attributes for the unknown party with those of the plurality of known parties (see., abstract, col 2, lines 58-col 3, line 15, col 4, lines 38-62, col 7, lines 19-55, col 8, lines 11-63, col 18, line 9- col 20, line 64).

As per claims 56 and 109 Hoffman discloses a method of accessing a database including a plurality of records, each record associated with a known party and including the plurality of attributes related thereto (see., abstract, col 2, lines 58-col 3, line 15, col 4, lines 38-62, col 7, lines 19-55, col 8, lines 11-63, col 18, line 9- col 20, line 64).

As per claims 57, 104, 105 and 110 Hoffman discloses a method of calculates an accumulated weighting factor for each known party by summing the weighting factors of the attributes of the known party which match those of the unknown party, and wherein the identifying step identifies the unknown party as the known party with the largest accumulated weighting factor (see., abstract, col 2, lines 58-col 3, line 15, col 4, lines 38-62, col 7, lines 19-55, col 8, lines 11-63, col 18, line 9- col 20, line 64).

As per claims 58, 106 and 111 Hoffman discloses a method wherein the plurality of attributes is selected from the group consisting of an agent name, a client name, a bank name, a bank account number, a credit card number, a home base location, an agent program name, a location or name of a source with which the unknown party communicates, and combinations thereof (see., abstract, col 2, lines 58-col 3, line 15, col 4, lines 38-62, col 7, lines 19-55, col 8, lines 11-63, col 18, line 9- col 20, line 64).

As per claims 59, 107 and 112 Hoffman discloses a method of scanning program code for the unknown party to determine attributes thereof (see., abstract, col 2, lines 58-col 3, line 15, col 4, lines 38-62, col 7, lines 19-55, col 8, lines 11-63, col 18, line 9- col 20, line 64).

As per claims 62 and 63 Hoffman discloses a program product wherein the signal bearing media is transmission recordable type media (see., abstract, col 2, lines 58-col

3, line 15, col 4, lines 38-62, col 7, lines 19-55, col 8, lines 11-63, col 18, line 9- col 20, line 64).

As per claim 115 Hoffman discloses a method of controlling the behavior of the intelligent agent includes controlling a negotiation strategy used by the intelligent agent when conducting an electronic interaction with the unknown party (see., abstract, col 2, lines 58-col 3, line 15, col 4, lines 38-62, col 7, lines 19-55, col 8, lines 11-63, col 18, line 9- col 20, line 64).

As per claim 116 Hoffman discloses a method wherein identifying the unknown party includes identifying the unknown party as being untrustworthy, and wherein controlling the behavior of the intelligent agent includes modifying the behavior of the intelligent agent to account for increased risk posed by the unknown party and continuing to interact with the unknown party using the modified behavior (see., abstract, col 2, lines 58-col 3, line 15, col 4, lines 38-62, col 7, lines 19-55, col 8, lines 11-63, col 18, line 9-col 20, line 64).

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 101

Claims 54-59 and 113-116 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court

precedent[1] and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, the claims fail prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. Additionally, the claims fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing. For example, the first method step of claim 54 recites "determining at least on attribute related to the unknown party" but fails to identify the machine that performs the "determining".

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[1] See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Claims 60-63 and 104-112 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to software per se.

(10) Response to Argument

IDSs filed on 11/21/2005 have been considered.

In response to Applicant's arguments, Applicant argues that:

a. Applicant maintains that Hoffman and Slotznick cannot be combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App & Inter);

and Es parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

b. " the unknown party is a party other than a client that has delegated at least one task to the intelligent agent". However, the Examiner respectfully disagrees with Applicant characterization of the prior art. The prior art Hoffman clearly discloses a tokenless identification system in which a correlative comparison of a unique biometrics sample, such as a finger print or voice recording, gathered directly from the person of an unknown user. Please note that the unknown party is readable as a biometric sample taken from a user, and the intelligent token is interpreted as a tokenless identification system.

c. " analyze attributes of a party to determine the identity of that party". As indicated above, Hoffman discloses a method of examining (or analyzing) the biometrics samples during registration and comparing such biometrics with a collection of biometrics samples from individuals who have been previously attempted to perpetrate fraud upon the system (see., Hoffman, col 7, lines 13-35).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be

treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Jacob C. Coppola/

Examiner, Art Unit 3621

Vincent Millin
Appeals Conf. Specialist

ANDREW J. FISCHER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR